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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT'S REPLY BRIEF

APPELLANTS: Jessica Malmborg CONFIRMATION NO. 3462  
SERIAL NO.: 09/919,105 GROUP ART UNIT: 2173  
FILED: July 31, 2001 EXAMINER: Dennis G. Bonshock  
TITLE: "USER INTERFACE FOR A MEDICAL DISPLAY DEVICE"

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

S I R:

In accordance with the provisions of 37 C.F.R. §41.41, Appellant herewith submits a Reply Brief in response to the Examiner's Answer dated August 25, 2005.'

In the section entitled "Status of Amendments After Final" of the Examiner's Answer at page 2 thereof, the Examiner stated Appellant's statement of the status of amendments after final rejection contained in the Brief is correct, and in the "Claims Appealed" section, the Examiner stated the copy of the appealed claims contained in the Appendix to the Brief is correct. With Appellant's Brief, Appellant submitted an Amendment after the final rejection, as was noted in the Brief. The Examiner did not make an explicit statement in the Answer as to whether this Amendment has been entered, however, in view of the aforementioned other statements made by the Examiner in the Answer, Appellant will assume that the Amendment has been entered.

In the section bridging pages 2 and 3 of the Examiner's Answer, the Examiner stated the rejection of claims 1-16 stands or falls together because Appellant's Brief did not include a statement in accordance with 37 C.F.R. §1.192(c)(7). The Examiner

noted that Appellant's Brief did group claims 13 and 16, but the Examiner disagreed with this grouping because the Examiner stated claims 13 and 16 pertain to different subject matter in different branches of the claim tree.

In response, Appellant first notes that 37 C.F.R. § 1.192(c)(7) does not govern the content of Appellant's Brief, having been superseded by 37 C.F.R. § 41.37. Under 37 C.F.R. § 41.37, a statement regarding grouping of claims is no longer required. As stated in 37 C.F.R. § 41.37(c)(1)(vii), the argument must treat each ground of rejection under a separate heading, and for each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. Conforming to this requirement, Appellant in the Brief grouped claims 13 and 16 together, under a separate heading, as required, because those claims were rejected together by the Examiner in the final rejection. If, as the Examiner stated in his Answer, claims 13 and 16 pertain to different subject matter in different branches of the claim tree, then it is not understood how the Examiner could group those claims together in the aforementioned rejection encompassing both of those claims.

In view of the manner by which the Examiner chose to formulate the final rejection, Appellant submits that this Appeal Brief is in full compliance with all provisions of 37 C.F.R. § 41.37.

Appellant's replies to the Examiner's Response to Arguments (starting at page 10 of the Examiner's Answer) is as follows:

With regard to the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, the Examiner did not address the distinction between the words "relation" and "interrelation" and seems to simply have repeated the same argument substituting the word "interrelation" in place of "relation."

The Examiner stated that Examiners are required to give claims their broadest reasonable interpretation in light of the supporting disclosure, with which Appellant of course agrees. The Examiner's definition of "inter-relation" is so broad, however, as to be trivial and therefore not reasonable. The Examiner appears to be contending that any displayed item on a display screen necessarily occupies a certain amount of space, and this thereby limits the amount of space that can be occupied by some other displayed item on the display screen, thereby creating an "inter-relation" between such displayed items. Under this definition, it would be impossible for any two displayed items *not* to have such an "inter-relationship," and Appellant's respectfully submits that giving a word a meaning that is so broad as to trivialize any distinctiveness associated with the word is, per se, a unreasonable interpretation.

With regard to all of the prior art rejections, Appellant respectfully submits that the Examiner has not rebutted Appellant's contention that if the Schaefer et al. reference were modified, even conceptually, to have an appearance close to that of the Feller display, this would necessarily result in a completely different manner of displaying the information, and would not display the same information with the same level of clarity, and inter-relation between adjacent sectors, as is disclosed (and intended) in the Schaefer et al. reference.

The Examiner responded to this statement by identifying citations from the Schaefer et al. reference that, according to the Examiner, suggested modifying the Schaefer et al. reference in the manner proposed by the Examiner. Appellant respectfully submits, however, that whatever citations the Examiner is able to identify in the Schaefer et al. reference, a rejection under 35 U.S.C. §103(a) cannot be substantiated if it will result in a combination that is contrary to the intended purpose

or manner of operation of the reference being modified. It is Appellant's position that modifying the Schaefer et al. reference in the manner proposed by the Examiner would change the displayed information in the Schaefer et al. reference in a way that would reduce the clarity and informational content thereof that the Schaefer et al. reference is intended to provide. The Schaefer et al. reference discloses a specific way of displaying the information, and this way of displaying the information is intended to achieve a particular result in the visual appearance of the displayed information. Schaefer et al. teach that this visual appearance is important for clearly and accurately and quickly conveying the content of the displayed information to the viewer. Departing from this visual appearance of the display, as would necessarily occur if the Schaefer et al. reference were modified as proposed by the Examiner, would at least alter, if not preclude, the informational content from being visualized in the same way as intended by Schaefer et al. Such a modification, regardless of the citations that can be marshaled to allegedly support it, is not permissible as a basis for a rejection under 35 U.S.C. §103(a). Appellant therefore respectfully submits the rejections of claims 1-16 should be reversed.

Appellant does not request an oral hearing.

Submitted by,

*Steven H. Noll*

(Reg. 28,982)

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### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on October 24, 2005.

*Steven H. Noll*

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